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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,554	04/08/2004	David H. Tannenbaum	05708/P005DIV/08008819	8358
29053	7590	03/10/2006	EXAMINER	
DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P. 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784			SALTARELLI, DOMINIC D	
		ART UNIT	PAPER NUMBER	2611

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/820,554	TANNENBAUM, DAVID H.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dominic D. Saltarelli	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 February 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 47,48,57 and 72-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 47,48,57 and 72-80 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/1/05</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 7, 2006 has been entered.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because line 1 contains the phrase "There is disclosed", which is implied. Correction is required. See MPEP § 608.01(b).

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 47, 48, 57, and 72-80 have been considered but are moot in view of the new grounds of rejection.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 47, 48, 57, and 72-80 are rejected under 35 U.S.C. 102(b) as being anticipated by Kwoh (5,852,478).

Regarding claim 47, Kwoh discloses a method of adjusting recording time of an entertainment program (col. 2, lines 21-55), said method comprising:

selecting an entertainment program to be communicated to a user's premises, said program having scheduled start and stop times (col. 2, lines 21-25),

establishing a start and stop time in accordance with said scheduled start and stop times for recorded said selected program at said user's premises (a predicted start time and the start time plus the expected length of the program equate to a start and stop time in accordance with the schedule, col. 2, lines 21-25),

without action taken by said user, adjusting an established stop time of said established recording time to accommodate subsequent changes in program length (col. 2, lines 50-55).

Regarding claim 48, Kwoh discloses the method of claim 47, wherein said changes in program length occur after the start time of said program (col. 2, lines 47-55).

Regarding claim 57, Kwoh discloses the method of claim 47, further comprising transmitting for recording at said user's premises said selected program in accordance with said established start and stop times (col. 2, lines 47-50).

Regarding claim 72, Kwoh discloses a method for the delivery from a delivery source of entertainment programs for delayed viewing by recipients of said entertainment program, said entertainment program having an unknown length (col. 2, lines 21-55), said method comprising:

establishing a starting time for a particular entertainment program so as to allow for the setting of a recorder at said recipient's premises for recording a delivered one of said entertainment programs starting at said starting time (col. 2, lines 21-25 and lines 39-50), and

communicating from said delivery source to said recipient's recorder a message when the length of said entertainment program becomes ascertainable by said delivery source so as to enable said recipient's recorder to stop recording said entertainment program in accordance with said message (col. 2, lines 50-55).

Regarding claim 73, Kwoh discloses the method of claim 72, wherein said setting of said recorder is under the direct control of said recipient (col. 2, lines 21-25).

Regarding claim 74, Kwoh discloses the method of claim 72, further comprising:

receiving from said recipient listings of entertainment programs desired to be received by said recipient (col. 2, lines 21-25); and

wherein said setting of said recorder is under control of said delivery source based upon received ones of said desired entertainment program (col. 2, lines 34-53).

Regarding claims 75 and 76, Kwoh discloses a method and device for the recording of entertainment programs at a recipient's location, said entertainment programs received from a delivery source, said entertainment programs having an unknown length (col. 2, lines 21-55), said method comprising:

setting of a recorder at said recipient's premises for recording a delivered one of said entertainment programs starting at a time as determined by said delivery source (col. 2, lines 39-50), and

receiving by said recorder a message from said delivery source when the length of said entertainment program becomes ascertainable by said delivery

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source so as to enable said recorder to stop recording said entertainment program (col. 2, lines 50-55).

Regarding claims 77 and 79, Kwoh discloses a method for recording TV programs at a user's premises, said TV programs delivered over a plurality of user selectable channels by a delivery source, said programs scheduled to begin at particular times (col. 2, lines 21-55), said method comprising:

setting in a recorder at said user's premises a particular channel and a particular start time corresponding to a program desired to be recorded by said user (col. 2, lines 21-25); and

receiving from said program source a message for use by said recorder to end said recording of said desired program (end time is adjusted for changes in length, col. 2, lines 50-55).

Regarding claims 78 and 80, Kwoh discloses the method of claims 77 and 79, wherein said message from said program source is contemporaneous with the end time of said desired program (col. 2, lines 50-52).

### ***Conclusion***

7. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information

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and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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on \_\_\_\_\_.  
(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_  
Signature: \_\_\_\_\_

Registration Number: \_\_\_\_\_

### **Certificate of Transmission**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. ( ) \_\_\_\_ - \_\_\_\_ on \_\_\_\_\_.  
(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_  
Signature: \_\_\_\_\_

Registration Number: \_\_\_\_\_

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DS



JOHN MILLER  
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